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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

14485RRUS01U

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on September 5, 2006

Signature

Typed or printed name Sherry Wolf McWhinnie

Application Number

09/981,268

Filed

October 17, 2001

First Named Inventor

Peter W. Wenzel

Art Unit

2617

Examiner

Willie J. Daniel, Jr.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 38,620

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

/Kevin L. Smith/

Signature

Kevin L. Smith, Reg. No. 38,620

Typed or printed name

972-772-8836

Telephone number

September 5, 2006

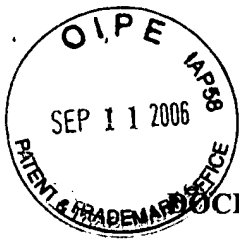
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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BUCKET NO. 14485RRUS01U  
Customer No. 49,403

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Wenzel et al.

Serial No. 09/981,268

Filed: October 17, 2001

For: Home Agent Redundancy  
in a Cellular System


Group No.: 2617

Examiner: Willie J. Daniel, Jr.

**CERTIFICATE OF MAILING UNDER RULE 8**

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By:

  
Sherry Wolf McWhinnie

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Alexandria, VA 22313-1450

**ARGUMENT ACCOMPANYING THE  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Submitted with the Pre-Appeal Brief Request for Review are these arguments and remarks, which are being filed with the filing of a notice of appeal, accompanied by the appropriate fee, and before the filing of an appeal brief.

A final office action had been mailed June 5, 2006, advising, in sum, that Claims 1 through 23 in the patent application 09/981,268 stand rejected as being unpatentable under 35 USC § 103(a). The rejections stem generally from the hypothetical combination of Ton in view of Perkins (*see* Final Office Action mailed June 5, 2006 [*hereinafter* Final Office Action]), namely that:

a. Claims 1, 7-9, 15, and 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application 2002/0067704 to Ton ("Ton") in view of Perkins "*IP Mobility Support*".

b. Claims 2, 3, 10, 11, 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ton in view of Perkins, "*IP Mobility Support*," and further in view of U.S. Publication No. 2002/0078238 ("Troxel").

c. Claims 4 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ton in view of Perkins, "*IP Mobility Support*," and further in view of Troxel, further in view of Jue et al.,

“*Design & Analysis of Replicated Server Architecture for Supporting IP-Host Mobility*” (“Jue”), even further in view of U.S. Patent No. 6,615,050 to Tiedmann et al. (“Tiedmann”).

d. Claims 5, 6, 13, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ton in view of Perkins, “*IP Mobility Support*,” and further in view of Troxel, further in view of Perkins “*Mobile Networking through Mobile IP*”, and even further in view of U.S. Patent No. 5,590,092 to Fehnel (“Fehnel”).

e. Claims 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ton in view of Perkins, “*IP Mobility Support*,” further in view of Troxel, and further in view of Perkins, “*Mobile Networking through Mobile IP*.”

f. Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ton in view of Perkins, “*IP Mobility Support*,” further in view of Troxel, and further in view of Jue.

Applicant respectfully submits that a *prima facie* basis for obviousness had not been established under the hypothetical combination of Ton in view Perkins, or their additional combination with other cited references for the reasons stated herein. Reconsideration of the Claims is respectfully requested.

## 1. Background

Application 09/981,268 involves a “subscriber unit [programmed] with a plurality of IP addresses, each corresponding to a home agent of the service provider. These programmed IP addresses include the IP addresses of a primary home agent and a secondary home agent. Upon an initial registration attempt, the subscriber unit attempts to register with its primary home agent. Should this operation fail, the subscriber unit attempts registration with its assigned secondary home agents.” (Specification at p. 3, *ll.* 13-21) (emphasis added).

Specifically, Applicant’s Independent Claim 1 recites, *inter alia*, a “method for registering a subscriber unit with a home agent in a cellular system, the method comprising: *storing addresses for a plurality of home agents in the subscriber unit*, wherein the plurality of home agents includes a primary home agent and a plurality of secondary home agents; . . . *failing to achieve registration with the primary home agent*; the subscriber unit selecting a secondary home agent from the plurality of secondary home agents . . . and attempting registration with the secondary home agent.” (emphasis added).

Applicant’s Independent Claim 10 recites a “method for registering a subscriber unit with a home agent in a cellular system, the method comprising: *storing addresses for a plurality of home agents in the subscriber unit*, wherein the plurality of home agents includes a primary home agent and a plurality of secondary home agents; attempting registration with the primary home agent; *failing to achieve registration with the primary home agent*; the subscriber unit rank ordering the plurality of secondary

home agents into at least a first secondary home agent and a second secondary home agent in an attempt to balance load among the plurality of secondary home agents; and attempting registration with the first secondary home agent.” (emphasis added).

Also, Applicant’s Independent Claim 15 recites, *inter alia*, a “subscriber unit that operates within a cellular system, the subscriber unit comprising: an antenna; a radio frequency unit coupled to the antenna; and at least one digital processor coupled to the radio frequency unit that executes software instructions causing the subscriber unit to: *store addresses for a plurality of home agents in the subscriber unit*, wherein the plurality of home agents includes a primary home agent and a plurality of secondary home agents; attempt registration with the primary home agent; *failing to achieve registration with the primary home agent*; . . . and attempt registration with the secondary home agent.” (emphasis added).

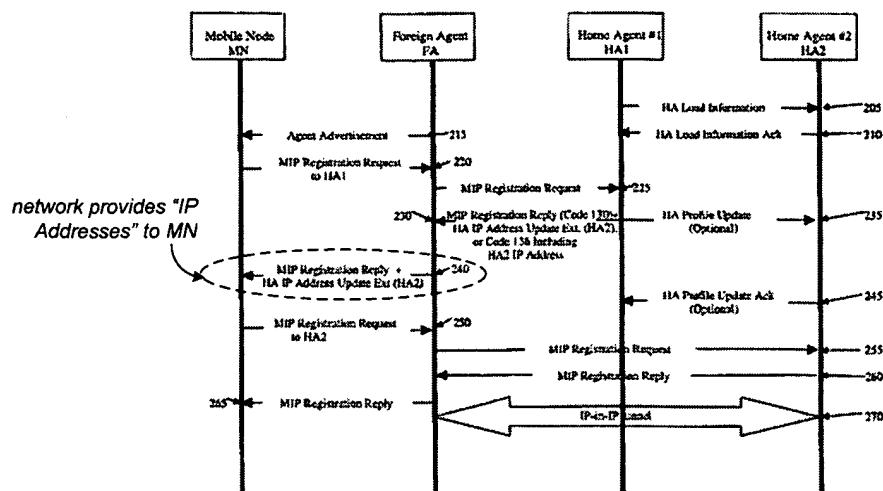
**2. *Prima Facie* case under 35 U.S.C. § 103(a) lacks some suggestion or motivation to modify the reference or to combine reference teachings**

***a. Following registration with the network via an agent, the network of Ton provides the secondary home agents, not the subscriber***

Ton recites a “network [that] will have a number of Mobile Nodes attached to the network. Each Mobile Node will have an IP address and be attached to the network through a Home Agent. When visiting another network a Mobile Node will register with that network through a Foreign Agent. The network will provide the addresses of secondary a number of Home Agents through which the Mobile Node may register, although the Mobile Node will be statically configured to register with a given Home Agent.” (Ton ¶ 0023).

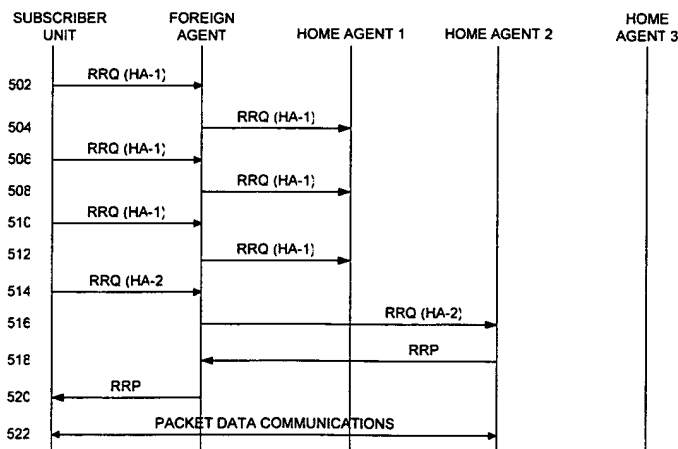
To avoid Home Agent failure following mobile node registration, Ton calls for “*an additional Mobile IP extension [that] is added to the registration reply message [that allows] the Mobile Node . . . to select a new secondary Home Agent to perform registration with in case the primary Home Agent fails.*” (Ton ¶ 0028).

In other words, Ton recites redundancy activity following *network registration*, such as through a foreign agent, instead of addressing an inability to register with the network. Under Ton, secondary addresses are then supplied by the network. This is supported in Figures 2-4 of Ton, in which secondary addresses are supplied by the network, and not by the mobile terminal. Referring by example to Figure 2 of Ton:



Under Ton, without the provisioning of an "IP Address Update" by the network, the mobile node would not have the capability, as understood, of accessing the secondary HA addresses.

In contrast, Applicant's Figure 5 does not reflect that the network provides "IP addresses" to the mobile node:



That is, as explained in Applicant's specification with respect to Figure 5, "a subscriber unit initiates registration with its assigned primary HA and, upon failure in this registration operation, the subscriber unit initiates registration with a secondary HA." (Specification at p. 14, ll. 2-6).

**b. Perkins does not address network access redundancy**

Section 3.6 of Perkins, "*IP Mobility Support*," recites that "a mobile node MAY be configured with the IP address of one or more of its home agents; otherwise, the mobile node MAY discover a home agent using the procedures described in Section 3.6.1.2." (Perkins, "*IP Mobility Support*," p. 33, § 3.6);

however, Applicant respectfully submits these home agents, as understood, are primary home agents in that “[a] home agent MUST always be prepared to serve the mobile nodes for which it is the home agent.” (*Id.* at p. 16) (original emphasis). In other words, the Home Agent of Perkins *would not be in an inoperable state to affect mobile node registration*. Accordingly, Perkins does not address instances where the home agent is inoperable and subsequent actions are taken by a mobile node to gain connectivity.

Accordingly, neither Ton nor Perkins addresses “*storing addresses for a plurality of home agents in the subscriber unit*,” “*failing to achieve registration*,” and subsequently “*attempting registration with a secondary home agent*.”

The Advisory Action mailed June 5, 2006, noted that the references may not be attacked individually; however, there must be some motivation-suggestion-or teaching that leads to the achieving Applicant’s claimed invention – neither Ton nor Perkins are suited for this task. The further addition of Troxel in rejection of Applicant’s Independent Claim 10 does not fill the void of Ton nor Perkins, and Applicant similarly submits that a *prima facie* case of obviousness is not established.

### **3. Conclusion**

Accordingly, Applicant respectfully submits that Claims 1-23 are in condition for allowance, and that the rejections be withdrawn stated herein.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126 (14485RRUS01U).

Respectfully submitted,

**Date: September 5, 2006**

**/Kevin L. Smith/**

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